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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,949	11/30/2000	Patrick C. Shutt	10127/37	V 5443
757	7590	09/21/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/727,949	SHUTT ET AL. <i>MW</i>	
	<b>Examiner</b>	<b>Art Unit</b>	3629
Igor Borissov			

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 June 2004.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-23 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 and 3-23 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

Claim 2 has been canceled. New claims 22 and 23 have been added.  
Claims 1, 3-23 are currently pending in the application.

### ***Examiner's Notice***

Claim 9. The examiner believes that the word "are" in the phrase "said subset ... are linked" should be substituted with "is".

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1, 19 and 23 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**As per claims 1, 19 and 23,** the phrase: "may be linked" makes claims confusing, because the word "may" expresses a potential capability, not an actual method step.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. (US 5,881,131).**

Farris et al. teach a method and system for provisioning network related facilities, comprising:

**As per claims 1, 10-11 and 13,**

-providing (obtaining) a plurality of network parameters information related to network segments (C. 8, L. 34-35) provided by network providers (column 8, lines 15-37);

- receiving a customer request for a circuit between said at least two terminal points (column 32, lines 36-40);

- evaluating said plurality of network parameters information in connection with a plurality of network parameters relating to said customer request to identify the network segments suitable for the task (column 34, lines 12-26);

- linking a plurality of network segments from a plurality of networks wherein said plurality of network segments is linked via at least one facilitator-controlled exchange facility to form a provisioned circuit between said at least two terminal points (column 32, lines 35-40, 46-48; column 33, lines 42-45; column 34, lines 20-22);

- providing access to the provisioned circuit to said customer (column 32, lines 35-40, 46-48; column 33, lines 42-45; column 34, lines 20-22).

Farris et al. do not specifically teach that said network providers are transport suppliers. However, there is not indication in the specification of advantages of using the term "transport suppliers" over the prior art. Without such indication, it appears that using said terminology would have been an obvious matter of business choice.

**As per claim 3,** Farris et al. teach said method and system wherein the database is updated to reflect the information relating to available network segments on a real-time basis (column 32, line 56 - column 36, line 42).

**As per claim 4,** Farris et al. teach said method and system, further comprising the step of providing a plurality of network parameter options to the

customer before the step of linking said plurality of network segments to form the provisioned circuit (column 5, lines 57-67; column 33, lines 36-42).

**As per claim 5,** Farris et al. teach said method and system, further comprising the steps of identifying at least one customized circuit option; and providing said at least one customized circuit option to the customer before the step of linking said plurality of network segments to form the provisioned circuit (column 5, lines 57-67; column 35, line 59 - column 36, line 47).

**As per claims 6 and 14,** Farris et al. teach said method and system wherein the step of identifying at least one customized circuit option further comprises the step of filtering a plurality of available circuit options with respect to at least one network parameter provided by the customer (column 5, lines 57-67; column 35, line 59 - column 36, line 42).

**As per claims 7 and 15,** Farris et al. teach said method and system wherein the customer request is received into an automated ordering and provisioning system (column 17, lines 3-26; column 38, lines 15-36).

**As per claims 8 and 16,** Farris et al. teach said method and system wherein the customer accesses the ordering and provisioning system via the Internet (column 20, line 5 - column 30, line 38).

**As per claim 9,** Farris et al. teach said method and system wherein the segments are linked using an automated ordering and provisioning system (column 17, lines 3-26; column 38, lines 15-36).

**As per claim 12,** Farris et al. teach said method and system, further comprising the step of providing a single point of contact for said customer in connection with billing and circuit maintenance procedures from said transport suppliers relating to said network segments (column 17, lines 3-26).

**As per claim 17,** Farris et al. teach said method and system wherein said facilitator further comprises a software program running on a server (column 20, line 5 - column 30, line 38; column 32, line 36 - column 36, line 42).

**As per claim 18,** Farris et al. teach said method and system wherein said facilitator further comprises at least one human operator (column 35, lines 20-22; column 38, lines 4-9, 39-46; column 47, lines 18-45).

**As per claims 19 and 20,** Farris et al. teach said method and system, comprising:

- at least one processing server in connection with a plurality of customers (column 20, line 5 - column 30, line 38; column 32, line 36 - column 36, line 42);

- a database resident on said at least one processing server, wherein the database is updated on a regular basis with information related to a plurality of network segments of a plurality of transport suppliers, and wherein said information is received from said plurality of transport suppliers (column 32, line 56 - column 36, line 42);

- a plurality of exchange facilities in communication with said at least one server for facilitating the linking of the network segments (column 32, line 36 - column 36, line 42);

- logic software resident on said at least one server and in communication with the database and the facilities to automate the linking of said network segments via said exchange facilities to form a provisioned circuit in accordance with a customer request (column 20, line 5 through column 30, line 38; column 32, line 36 - column 36, line 42).

**As per claim 21,** Farris et al. teach said method and system, further comprising means for evaluating said database information and means for providing a plurality of circuit options in accordance with said customer request (column 32, line 56 - column 36, line 42).

**As per claim 22,** Farris et al. teach said method and system, further comprising

- providing (obtaining) a plurality of network parameters information related to network segments (C. 8, L. 34-35) provided by network providers (column 8, lines 15-37);

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- receiving a customer request for a circuit between said at least two terminal points (column 32, lines 36-40);
  - evaluating said plurality of network parameters information in connection with a plurality of network parameters relating to said customer request to identify the network segments suitable for the task (column 34, lines 12-26);
    - linking a plurality of network segments from a plurality of networks wherein said plurality of network segments is linked via at least one facilitator-controlled exchange facility to form a provisioned circuit between said at least two terminal points (column 32, lines 35-40, 46-48; column 33, lines 42-45; column 34, lines 20-22); wherein said linking of said network segments obviously indicates requesting and obtaining access to said network segments;
    - providing access to the provisioned circuit to said customer (column 32, lines 35-40, 46-48; column 33, lines 42-45; column 34, lines 20-22).

Farris et al. do not specifically teach that said network providers are transport suppliers. However, there is not indication in the specification of advantages of using the term "transport suppliers" over the prior art. Without such indication, it appears that using said terminology would have been an obvious matter of business choice.

**As per claim 23,** Farris et al. teach said method and system, comprising:

- providing (obtaining) a plurality of network parameters information related to network segments (C. 8, L. 34-35) provided by network providers (column 8, lines 15-37);
  - receiving a customer request for a circuit between said at least two terminal points (column 32, lines 36-40);
    - evaluating said plurality of network parameters information in connection with a plurality of network parameters relating to said customer request to identify the network segments suitable for the task (column 34, lines 12-26);
      - linking a plurality of network segments from a plurality of networks wherein said plurality of network segments is linked via at least one facilitator-controlled exchange facility to form a provisioned circuit between said at least

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two terminal points (column 32, lines 35-40, 46-48; column 33, lines 42-45; column 34, lines 20-22- providing access to the provisioned circuit to said customer (column 32, lines 35-40, 46-48; column 33, lines 42-45; column 34, lines 20-22). Farris et al. do not specifically teach that said network providers are transport suppliers. However, there is not indication in the specification of advantages of using the term "transport suppliers" over the prior art. Without such indication, it appears that using said terminology would have been an obvious matter of business choice. As to providing (obtaining) a *second* and *third* plurality of network parameters, method steps disclosed in Farris et al. obviously indicate a continuity of the method.

### ***Response to Arguments***

Applicant's arguments filed 29/06/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Farris et al. fail to show a *plurality of network segments*, the examiner points out that Farris et al. does, in fact, teach this feature (See: column 8, lines 34-35).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***  
***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB  
9/10/2004

  
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